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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,280	04/24/2000	Henry F. McNemey	L0532/7010	7997

7590 11/01/2002

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EXAMINER

ROSENBERGER, RICHARD A

ART UNIT PAPER NUMBER

2877

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,280

Applicant(s)

McInerney et al

Examiner

Richard Rosenberger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 22, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above, claim(s) 1-11 and 24-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8, 9 6) ☐ Other:

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1. Applicant's election of the invention of claims 12-23, identified in the restriction requirement as group II, in Paper No. 12, filed 22 July 2002, is acknowledged. It is noted that no reasons were advance as to any error in the requirement; therefore the election was made without traverse.

The non-elected claims 1-11, and 24-85 should be cancelled. It is noted that cancellation of these claims will in no way prejudice the filing of these claims or other claims directed to the inventions being therein claimed in divisional applications.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liang (US 5,719,948).

Liang shows using device for detecting a mark on a substrate, the mark including a light-sensitive compound that emits or absorbs light at a first wavelength; note lines 4-7 of the abstract which discusses "graphic images and/or

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characters [which] have been previously made with fluorescent substances that may be invisible under ordinary visible light, but are rendered detectable by the ultraviolet light.”

The reference teaches a detector which operates in two modes, one capturing a visible light image (a “video mode”) and one capturing an image with the emission or absorption (a “snapshot mode”); “[t]he detector may be capable of detecting both fluorescent images and normal visible images, and the authentication system may incorporate switching mechanisms to allow multiplexed acquisition of fluorescent and normally visible images” (abstract, lines 17-21). There is a light source (“a source of UV light”, abstract, lines 11-12) for irradiating the sample in the “snapshot”, or fluorescent, mode.

The Liang reference discusses human observation; in the abstract there is a mention of using characters that are “readable by human readers once they are made visible” (lines 9-10) and that “[p]airs of indicia to be recognized and/or compared may be arranged to constitute a stereogram or other arrangement for first-order authentication by a human observer” (abstract, lines 32-35); clearly this “first-order authentication by a human observer” must include, and is intended to include, a display of both images obtained in both “modes”.

The reference discusses storing the images obtained in digital form in computer memory (column 12, lines 44-49). If a permanent record is desired of the

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test, it would have been obvious to create one using film or the like to do so. Time and date stamping is a common practice.

The reference teaches the light may be a "strobe lamp" (column 5, line 39), which is a type of flash. Other types of flash may be used as it is the provision of suitable illumination, and not the particular means to supply it, that is of functional importance.

The reference teaches that "[f]or some applications it is desirable to insert other optical filters 50 (not shown) into illumination portions 15 of optical path between sources 10 and/or 20 and beam splitter 30, to select portions of the UV and/or visible/IR spectra with which to illuminate article 25" (column 5, lines 63 through column 6, line 1); selecting the filter to provide the wavelength appropriate for the particular mark would have been obvious.

Touch screens are known manners of entering data and commands into computers and computer controlled systems and it would have been obvious to use this known technique. The particular manner in which the two images are displayed, both at the same time on a split screen, alternately, in color, etc., is a matter of design choice well within the ordinary skill of those in the art.

4. There are no copies of references in the file for the IDS, form PTO-1449, filed 16 January 2001, paper no. 8. Those documents that are readily available to the

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examiner through other means have been considered, three foreign documents are not readily available and have thus have not been considered, and have thus been lines through.

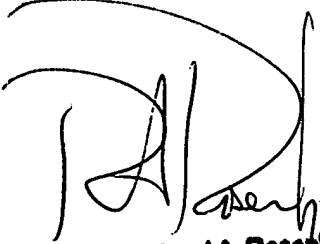
There are no copies of references in the file for the IDS, form PTO-1449, filed 30 August 2000, paper no. 5. Due to the number of cited references, it is not feasible for the examiner to attempt to obtain these by other means. Therefor none of these documents have been considered, and all have been lined through.

5. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 308-7722.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
30 October 2002



Richard A. Rosenberger
Primary Examiner